SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

October Term, 1968

No. [redacted] 154

FORT HOWARD PAPER COMPANY, a Corporation,
Opposer-Petitioner,

vs.

KIMBERLY-CLARK CORPORATION, a Corporation,
Applicant-Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Applicant-Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Petitioner prays that a writ of certiorari issue to review the decision of the United States Court of Customs and Patent Appeals entered in the above entitled Trade Mark Opposition on March 14, 1968.

Opinions Below

The decision of the Trademark Trial and Appeal Board of the United States Patent Office is reported at 148 USPQ 607, and is reprinted in the Appendix "C" hereto annexed p. 15. The opinion of the United States Court of Customs and Patent Appeals is reported at 157 USPQ 55, and is reprinted in the Appendix "A" hereto annexed p. 8.

Jurisdiction

The jurisdiction of this Court is invoked under 28 USC Sec. 1256.

Questions Presented

1. Do the Federal Trademark Statutes permit a party to make use of an application for federal trademark registration to reserve rights to a proposed trademark which is, in fact, not in legitimate commercial use at the time of filing the trademark application? This presents an important question of trademark law under the Lanham Act which has never been decided by this Court.

2. Did the United States Court of Customs and Patent Appeals approve a practice which is directly contrary to the Federal Trademark Statutes when it held that a token shipment, consisting of a few boxes of sanitary paper items, sent to a drug store by the legal department of Kimberly-Clark Corporation, which was admittedly not followed by any commercial sales for eighteen months, was a proper "use in commerce" on which to base the filing of an application for United States trademark registration, when the mark was not in commercial use at the time the affidavit attached to the trademark application was executed, which affidavit incorrectly stated that the mark was "in use" on the date of filing?

3. Did the United States Court of Customs and Patent Appeals decide a federal question contrary to the intent of the Federal Trademark Statutes, as expressed in the last paragraph of Sec. 45, 15 USC 1127 ("* * * to prevent fraud and deception in such commerce by the use of * * * colorable immitations of registrable marks") and when it held that, "Notwithstanding the apparent similarities between 'So-Dri' and 'Hi-Dri' * * *" there was no likelihood of confusion or mistake as to the source of goods sold thereunder, the Court having previously concluded that there was "identity of goods"?

Statement of this Case

This is a trademark opposition case which originated in the United States Patent Office. Opposer-Petitioner, Fort Howard Paper Company, brought the opposition "based on the admittedly long prior use as trademarks for paper towels of 'So-Dri' * * *" (Decision of CCPA, p. 1). This use began in 1922, Opposer-Petitioner being the owner of Trademark Registration No. 165,832, registered March 20, 1923, for "Sodri", of Registration No. 651,196, registered September 3, 1957, for "Sodri", and of Registration No. 651,198, registered September 3, 1957, for "So-Dri". Applicant-Respondent, Kimberly-Clark Corporation, filed an application to register "Hi-Dri" as applied to absorbent paper tissue suitable for hygenic, cosmetic or cleaning purposes on January 15, 1963, based upon an alleged use in interstate commerce on December 27, 1962, consisting of a single shipment of $1.91 worth of goods to a drug store in Illinois, which was admittedly not followed by any legitimate commercial sale for eighteen months. When the trademark application was executed on January 14, 1963, Applicant's official swore to the truth of the statement that the trademark "is now in use in such commerce". The record shows that the trademark was not in commercial use in commerce on January 14th, and that the first commercial sale occurred some eighteen months later.

The United States Trademark Statutes, 15 USC 1051, Sec. 1, provide for registration by "the owner of a trademark *used in commerce*" (emphasis ours) and requires that applicant, in his written application, state "the date of applicant's first use of the mark in commerce" and also "that the mark *is in use* in commerce" (emphasis ours) at the time of filing the application. Even if the token shipment by the legal department, which the Trademark Trial and

Appeal Board stated in its decision "was deliberately made for federal registration purposes" is accepted as a proper "use in commerce" under the Statute, there was admittedly no further use, following this $1.91 token shipment, for eighteen months. Therefore, the trademark was not "in use in commerce" at the time of executing the trademark application on January 14, 1963. Thus the Court of Customs and Patent Appeals has approved an exceedingly dangerous practice which is directly contrary to both the intent and wording of the United States Trademark Statutes. It is also in conflict with the dicta of this Court in *United Drug vs. Rectanus,* 248 U. S. 90, which states that the right to a particular mark grows out of its use—not its mere adoption. This language is also directly applicable to the 1946 Trademark Act.

The Court of Customs and Patent Appeals recognized "the apparent similarities between 'So-Dri' in particular and 'Hi-Dri' " (decision p. 3) and held that there was "identity of goods" (decision p. 2), and that "Appellant's opposition is based on the admittedly long prior use* * *" (decision p. 1). With these facts in mind any holding that there is no likelihood of confusion between "Hi-Dri" and "So-Dri" is directly contrary to the Federal Trademark Statutes.

Reasons for Granting the Petition for Writ of Certiorari

It is exceedingly important that the present Petitioner, as well as the public in general, be protected against the existence of "paper registrations" not based upon legitimate commercial use in commerce. By its decision in the present case, the Court of Customs and Patent Appeals has placed its stamp of approval upon filing a trademark application based upon a token shipment by the legal

department which was not followed by any legitimate activity for eighteen months. This leaves the door open for parties to attempt to reserve trademark rights by way of registrations not based on legitimate commercial usage. This also leaves the door open for the owners of such "paper registrations" to harass legitimate trademark users who may later adopt trademarks based on legitimate usage which are too close to said "paper registrations". Such practice has in the past existed in certain Latin American and South American countries, and legitimate United States manufacturers have been faced with problems when trying to enter such countries because of such registrations. The decision of the Court of Customs and Patent Appeals could also result in a highly objectionable cluttering of the trademark records with "paper registrations" not based on legitimate commercial usage, taken out either for the purpose of reserving a word for possible future use or for some ulterior purpose—in either event contrary to the provisions of the Statutes. It is submitted that this presents an important question of Federal Law in interpretation of the Lanham Trademark Act, which has not been, but should be, settled by this Court.

It is also submitted that the decision of the Court of Customs and Patent Appeals holding that there is no likelihood of confusion between "HI-DRI" and "SO-DRI", both used on *identical,* casually purchased, inexpensive products, is in conflict with the provisions of the Federal Trademark Statutes. These statutes provide in Sec. 2(d), 15 U. S. C. 1052, for refusal of registration where the mark "consists of or comprises a mark which so resembles a mark registered in the Patent Office or a trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of ap-

plicant, to cause confusion, or to cause mistake, or to deceive * * *", and the purpose of the Trademark Statutes, as expressed in the last paragraph of Sec. 45, 15 U. S. C. 1127, is "to prevent fraud and deception in such commerce by the use of * * * colorable imitations of registrable marks." Considering the fact that the Court of Customs and Patent Appeals held that there was "identity of goods" (Decision, p. 2), that "Appellant's opposition is based on the admittedly long prior use * * *" (Decision, p. 1) and considering the Court's recognition of "the apparent similarities between So-Dri in particular and Hi-Dri" (Decision, p. 3), and considering the fact that petitioner has had a registration since 1923, a finding that use by the newcomer of Hi-Dri is likely to cause confusion or to cause mistake or to deceive should naturally follow under any reasonable reading of the Statutes. The decision of the Court of Customs and Patent Appeals is also in direct conflict with other decisions of the same Court involving two-syllable marks where the last syllable is suggestive. In 1965 the Court of Customs and Patent Appeals, in the case of *The Magnavox Company vs. Multivox Corporation of America,* 144 USPQ 501; 341 F. 2d 139, held that there was likelihood of confusion between "Multivox" on electric organs and "Magnavox" on radios, phonographs and television sets. This case involved a substantial difference in goods, the goods were expensive, and the common suffix "Vox" is at least suggestive of a characteristic of the goods. It is, therefore, inconceivable that the same Court, three years later, could hold "Hi-Dr" and "So-Dri" not likely to result in confusion where they are both used on identical products of an inexpensive nature, bought casually.

The present decision is also in conflict with the decision of the Court of Customs and Patent Appeals in the case of

The Coca-Cola Company vs. Clay, 139 USPQ 308; 324 F. 2d 198, where the Court held that there was a likelihood of confusion between "Cup-O'-Cola" and "Coca-Cola". The reasoning of the Court in the latter case was that "the semantic differences which may exist * * * would we think be lost on the average purchaser in the marketplace. Certainly they would be outweighed by the phonetic and visual similarities." In this case the suffix "Cola" had a descriptive connotation. If the reasoning of the Court in the above two cases were applied to the present situation, where the products are identical, inexpensive and bought casually, there could be only one result, i.e. likelihood of confusion. This Court should resolve the apparent conflict between this decision and prior decisions of the Court of Customs and Patent Appeals so that trademark users may have proper and consistent guidance.

Conclusion

In view of the foregoing, a Writ of Certiorari should issue to review the judgment of the United States Court of Customs and Patent Appeals in the above entitled cause.

Respectfully submitted,

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APPENDICES TO PETITION FOR WRIT OF CERTIORARI

APPENDIX "A"

Opinion of the United States Court of Customs and Patent Appeals

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1967.
Patent Appeal No. 7915.
Opposition No. 43,376.

FORT HOWARD PAPER COMPANY,
Appellant,

v.

KIMBERLY-CLARK CORPORATION,
Appellee.

March 14, 1968

RICH, Judge.

This appeal is from a decision of the Patent Office Trademark Trial and Appeal Board, 148 USPQ 607, dismissing appellant's opposition to the registration by appellee of "Hi-Dri" on the Principal Register for "Absorbent Paper Tissue Suitable for Hygienic, Cosmetic, or Cleaning Purposes," serial No. 160,711, filed January 15, 1963, claiming first use December 27, 1962.

Appellant's oppositon is based on the admittedly long prior use as trademarks for paper towels of "So-Dri,"[1] principally relied on, its earlier-used variant "Sodri,"[2] and "Shur-Dri."[3]

Both parties took testimony, the witnesses for each side being cross-examined by counsel for the other.

The appeal presents two issues: (1) likelihood of confusion, etc., within the meaning of section 2(d) of the Lanham Act (15 USC 1052(d));[4] (2) whether appellee made bona fide commercial use of its mark so as to support right to register.[5]

The essential facts shown by the testimony and exhibits are adequately summarized in the board's published opinion and we see no need to repeat them. The highlights are that opposer's registered marks have been used extensively on paper towels designed and sold to automotive service stations for cleaning windshields and the like. Applicant's goods include paper towels and there is, therefore, identity of goods.

A key factor in the board's decision of no likelihood of confusion is the descriptiveness of the term "dry" or "dri" as applied to any kind of towel and the apparent commonplace use of that term as a syllable or part of trademarks adopted and used by applicant-appellee and third parties

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[1] Reg. No. 651,198, Sept. 3, 1957, for paper towels.

[2] Reg. No. 165,832, Mar. 20, 1923, twice renewed, last renewal for paper towels only, and No. 651,196, Sept. 3, 1957, for paper towels.

[3] Reg. No. 720,359, Aug. 22, 1961, for paper towels.

[4] Appellant makes two issues out of this by separately stating them as "confusing similarity" of the marks and likelihood of confusion, mistake or deception. These are, however, inseparable aspects of a single issue, as we view the matter.

[5] There is no question but that the mark was used, under conditions hereinafter explained, and appellant disavows any reliance on a theory of abandonment.

for towels of both paper and cloth. The record shows use by what is now a division of applicant, Kimberly-Clark, since 1911, of "Driwell" on paper towels, Reg. No. 522,321, except for the period 1924-1934 when "Drytex" was used instead. In the 1941-1964 period some 2,000,000 cases of "Driwell" towels were sold. Kimberly-Clark also has a registration of "Kaydry," No. 774,552, for disposable towels which the record shows to be paper towels. There are, in addition, 25 third-party registrations of record of marks containing "dry" or "dri," 11 of them for paper towels and 14 for cloth towels. The paper towel marks are in several instances the subject of recent or renewed registrations, indicating a probability of recent or present use.

Notwithstanding the apparent similarities between "So-Dri" in particular and "Hi-Dri," the board concluded there would be no likelihood of confusion on the following basis:

> Opposer's marks "So-Dri" and "Shur-Dri" and applicant's mark "Hi-Dri" obviously were adopted to suggest that the paper towels sold thereunder possess superior drying qualities. It likewise appears from the record that it has been a common practice for producers of paper towels and of such competitive products as cloth towels to adopt as trademarks for their products designations comprising the word "Dry" or "Dri", having a similar suggestive connotation, such as "Dri-N-Shine", "Dri-Kleen", "Dry-Mor", "Sparkle-Dri", "Easi-Dri", "Dryfast", and "Wipemdri". Under such circumstances, the scope of protection afforded opposer's marks must necessarily be narrow and manifestly cannot extend to preclude the registration by others of similar but otherwise distinguishable notations or trademarks for towels. [Cases cited.] * * * The fact, as urged by opposer, that its marks and that of applicant are hyphenated marks and the syllable "Dri" appears therein as a prefix instead of a suffix as in the third-party registrations is of no particular significance * * *. Accordingly, although the designations "So-Dri", "Shur-Dri",

> and "Hi-Dri" may have similar meanings, the differences between them in both sound and appearances are sufficient in view of the nature of the marks, to preclude a likelihood of confusion or mistake as to the source of the goods sold thereunder.

We see no clear error in that conclusion or in the reasoning by which it was reached.

Compare *Fort Howard Paper Co.* v. *Gulf States Paper Corp.*, 54 CCPA 1375, 376 F. 2d 904, 153 USPQ 646, where opposition to registration of "E-Z NAPS" by the owner of "HANDINAP" and "HANDINAPS" was dismissed, the goods of both parties being paper napkins.

On the second issue, it is opposer's contention that there was no bona fide use of "Hi-Dri" in commerce adequate to support a registration. Briefly, the facts are as follows. Kimberly-Clark's legal department made careful arrangements for the interstate shipment and sale on December 12, 1962, from its plant in Neenah, Wisconsin, to a drugstore in Waukegan, Illinois, of six boxes each of facial tissues, table napkins, toilet tissues and paper towels, all boxed or wrapped in coverings bearing the "Hi-Dri" trademark printed thereon. No further sales were made until July 1964, a period of eighteen months. Then sales under the mark were made as follows: July, 40 cases of toilet tissue and 260 cases of facial tissue; October, 700 cases of toilet tissue, 530 cases of facial tissue, and 357 cases of towels; November, 350 cases of toilet tissue and 50 cases of napkins. The total value of 1964 sales under the mark was $15,013.60.

Appellant argues that the first sale was not "bona fide," that the mark was not actually in use at the time the application was filed, some 18 days later, and that the 1964 sales were obviously stimulated by the opposition.

The board characterized this issue as an *"ex parte"* matter but considered it anyway, "in the interest of re-

moving any cloud that may be placed on applicant's activities in regard to its use of 'Hi-Dri' * * *." Since the board considered it, we will consider it.[6]

The board held, in effect, that applicant has complied with the law, and that although the initial sale was deliberately made expressly for federal registration purposes, this fact "is not damning *per se*" where the record shows there was an intent to continue to use the mark, and that such use was in fact continued. The board relied on the following cases: *Montgomery Ward & Co.* v. *Sears, Roebuck & Co.*, 18 CCPA 1386, 49 F. 2d 842, 9 USPQ 524; *California Spray-Chemical Corp.* v. *Ansbacher Siegle Corp.*, 55 USPQ 298 (Comm'r); *Western Stove Co.* v. *Geo. D. Roper Corp.*, 80 USPQ 393 (S. D. Cal. 1949); and *Maternally Yours, Inc.* v. *Your Maternity Shop, Inc.*, 110 USPQ 462 (2d Cir. 1956). Appellant attempts, unsuccessfully we think, to distinguish these cases. Appellee's testimony was that it normally takes it about three years after adoption and first use of a new mark to take the necessary steps leading to national distribution of a product under it, during which time marketing and advertising tests and preparation for production and sale are progressing. An eighteen-month hiatus in sales, absent any indication of an intent not to proceed, does not seem to us unreasonable. We think it appropriate that appellee should proceed with caution to try out its right to registration of "Hi-Dri," as it is doing in this proceeding, before plunging into the market with more extensive sales than it did. We agree with the board's decision that appellee complied with the law.

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[6] We do not know why an opposer should be precluded from raising this reason for denying registration in an *inter partes* proceeding. See *Roger & Gallet v. Janmarie, Inc.*, 46 CCPA 787, 263 F. 2d 350, 120 USPQ 484, on the delay of final disposition which may result from the characterization of rulings as *"ex parte."* Here both parties are arguing the question and neither questions our right to pass upon it.

For the foregoing reasons, the decision dismissing the opposition is *affirmed.*

AFFIRMED

WORLEY, C. J., did not participate.

APPENDIX "B"

Mandate of the United States Court of Customs and Patent Appeals

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

OCTOBER TERM, 1967

March 14, 1968

FORT HOWARD PAPER COMPANY,
Appellant,

v.

KIMBERLY-CLARK CORPORATION,
Appellee.

Patent Appeal No. 7915.

Subject Matter: Trademark for absorbent paper tissue suitable for hygienic, cosmetic or cleaning purposes.

Opposition No. 43,376.

Said appeal having heretofore been brought on to be heard before the court and due consideration having been had, it is—

ORDERED that the decision of the Trademark Trial and Appeal Board be, and the same is hereby, affirmed.

I, GEORGE E. HUTCHINSON, Clerk of the United States Court of Customs and Patent Appeals, do hereby certify that the above judgment and the attached opinion are true and correct copies of the judgment and opinion of said United States Court of Customs and Patent Appeals filed the 14th day of March, A. D. 1968, in the above-entitled appeal, as the same remain upon the files and records of said court.

WITNESS my hand and the seal of this court this 19th day of April, A. D. 1968.

(Signed) GEORGE E. HUTCHINSON,
Clerk.

APPENDIX "C"

Opinion of the Trademark Trial and Appeal Board of the United States Patent Office

Hearing: October 5, 1965 — VLH Paper No. 28

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Trademark Trial and Appeal Board

FORT HOWARD PAPER COMPANY,
v.
KIMBERLY-CLARK CORPORATION.

Opposition No. 43,376, to application Serial No. 160,711, filed January 15, 1963.

Morsell & Morsell and Paul J. Schierl for Fort Howard Paper Company.

Paul J. Glaister and Florence E. Miller and Hume, Groen, Clement & Hume for Kimberly-Clark Corporation.

Before Waldstreicher, Lefkowitz, and Shryock, Members.

Opinion by Lefkowitz, Member:

An application has been filed by Kimberly-Clark Corporation to register "HI-DRI" as a trademark for absorbent paper tissue suitable for hygienic, cosmetic or cleaning purposes. Use of the mark since December 27, 1962 has been alleged.

Registration has been opposed by Fort Howard Paper Company, which alleges that applicant's mark "HI-DRI" so resembles "SO-DRI", [1] "SODRI",[2] and "SHUR-DRI"[3] previously used and registered by opposer for absorbent paper tissue suitable for hygienic or cleaning purposes and, in particular, paper towels, as to be likely, when applied to applicant's goods to cause confusion or mistake or to deceive.

Both parties have taken testimony.

According to its record, opposer is engaged in the manufacture and sale of a general line of sanitary paper products, which include toilet tissue, paper towels, paper napkins, and printed specialties, the bulk of which is designed for and directed to industrial and commercial use. Opposer has sold paper towels designed and merchandised especially for use in service stations to wipe and clean windshields and other portions of automobiles under the marks "SO-DRI" and "SHUR-DRI" since 1956 or the spring of 1957 and 1960, respectively. Prior to 1956 or thereabout, opposer used the trademark "SODRI" to identify a general purpose hand towel sold with or without a dispenser for use in washrooms in factories, restaurants, schools, and like commercial and institutional establishments. Opposer's windshield wiper towels are marketed throughout the continental United States and possibly also in Hawaii through wholesale paper merchants, janitorial supply houses, wholesale automobile supply merchants, and institutional wholesalers who ordinarily also handle paper products of other producers. The marks "SO-DRI" and "SHUR-DRI" have been applied to labels and wrappers

(1) Reg. No. 651,198, issued Sept. 3, 1957.

(2) Reg. No. 165,832, issued Mar. 20, 1923, and twice renewed, and Reg. No. 651,196, issued Sept. 3, 1957.

(3) Reg. No. 720,359, issued Aug. 22, 1961.

for the goods as well as to the containers therefor. Sales of "So-Dri" towels since 1960 have been in excess of one hundred thousand dollars a year. "So-Dri" towels have been promoted by advertisements in the trade publications, "Jobber Topics", "Super Service Station", and "Gasoline Retailer", and through the distribution of posters, catalog sheets, flyers, and mailing pieces. Opposer has, since the introduction of windshield towels under the mark "So-Dri", expended approximately a hundred thousand dollars for magazine advertising as well as additional thousands of dollars for preparing and distributing promotional material directed to this product.

Applicant, like opposer, is a large manufacturer of paper products, including a variety of absorbent paper products such as towels, tissue, toilet paper, and table napkins. The first shipment of products in the United States under the mark "Hi-Dri" was made on December 27, 1962 when six boxes of "Hi-Dri" facial tissue, six boxes of "Hi-Dri" table napkins, six rolls of "Hi-Dri" toilet tissue, and six rolls of "Hi-Dri" towels were shipped in interstate commerce to Osco Drug of Waukegan, Illinois. The labels and cartons bore the trademark "Hi-Dri". The total shipment amounted to one dollar and ninety-one cents. The subject application was filed on January 15, 1963. Except possibly for some sales in Canada in connection with the registration of the mark in that country, no further shipments of goods under the mark "Hi-Dri" were made by applicant until July 1964.[4] The lapse of time between shipments, according

[4] Applicant's witness has testified to alleged extensive use of the mark "Hi-Dri" on paper products by its subsidiary in England and other foreign countries. But, apart from the fact that such asserted use does not antedate opposer's use of its pleaded marks, it is well established that use of a mark in commerce outside the jurisdiction of the Congress cannot establish or create rights in a trademark which a party can properly assert in a proceeding of the character here involved.

to applicant's testimony, was the normal lapse of time between the date on which a decision is reached to introduce a new product and the date when such product is placed in national distribution. In the interval, applicant usually conducts market tests, advertising tests, evaluations of the product, determines the best advertising format, and otherwise takes measures which it has found necessary prior to the distribution of a product nationally. Applicant's sales of "HI-DRI" products amounted to a sum slightly in excess of one thousand seven hundred dollars in July, 1964, a sum in excess of ten thousand dollars in October, 1964, and about thirty-one hundred dollars in November, 1964. Applicant's line of "HI-DRI" paper products are sold exclusively through its industrial or commercial division throughout most of the United States directly to multiple outlet users such as hotels, motels, airlines, factories, and the like and through merchant wholesalers who handle a general line of paper goods, janitorial supply merchant wholesalers, and similar wholesalers for resale to jobbers who in turn sell to institutional and commercial users. Admittedly, "Hi-Dri" paper products would be sold to filling stations either directly if they are a part of a large chain or through jobbers.

Applicant's record also contains testimony and documentary evidence as to its use and registration of the trademark "KAYDRY" for paper products and use, over the years, by one of its subsidiaries of the marks "DRYTEX" and "DRIWELL" for simliar goods. Considering, the substantial and obvious differences between these marks and "HI-DRI", the mark for which registration is sought, the use and registration of these marks is immaterial and irrelevant to the issue joined by the parties in this proceeding except to the extent that they show that applicant and its subsidiary have used other marks for paper goods comprising the term

"DRY" and its equivalent "DRI".[5] Apropos thereto, applicant has made of record under the applicable rule copies of twenty-five additional registrations issued to third persons for marks comprising the term "DRY" or "DRI" for paper and cloth towels.

The primary question for determination herein is whether or not a registration to applicant of "HI-DRI" for its paper products is likely to cause confusion in trade in view of opposer's ownership of and prior rights in the registered trademarks "SO-DRI" or "SODRI" and "SHUR-DRI". The fact that these marks are used by the parties in conjunction with or in close proximity to their corporate names is not germane to the resolution of this question. See: Frances Denney v. Elizabeth Arden Sales Corporation, 120 US PQ 480 (CCPA, 1959) and Sealy, Incorporated v. Simmons Company, 121 USPQ 456 (CCPA, 1959).

Opposer has attempted to establish the likelihood of such confusion by introducing in evidence testimony by two operators of service stations in Green Bay, Wisconsin where opposer is located to the effect that they utilize "SO-DRI" windshield towels in their businesses and that if they were to encounter "HI-DRI" towels, they would be likely to assume that they originate with the same producer. This testimony amounts to nothing more than an expression of opinion by the witnesses. And it is well settled that such testimony is entitled to little, if any, probative value in determining the question of likelihood of confusion. As stated by the court in The Quaker Oats Company v. St. Joe Processing Company, Inc., 109 USPQ 390 (CCPA, 1956) at page 391:

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[5] Salem Commodities, Incorporated v. The Miami Margarine Company, 114 USPQ 124 (CCPA, 1957); American Cyanamid Company, v. Synthetic Nitrogen Products Corp., 13 USPQ 421 (CCPA, 1932); and Maize Industries v. The Holloway Trust, 128 USPQ 19 (TT&A Bd., 1960).

> "If such testimony were adopted without considering other aspects of the case, the effect would be to substitute the opinions of the witnesses for the ultimate decision to be reached by the court and would therefore be improper."

See also: Fort Howard Paper Company v. Gulf States Paper Corporation, 146 USPQ 593 (TT&A Bd., 1965).

Turning now to the question that we must determine, the goods of both parties comprise hand towels and closely related paper products which are sold through various types of non-inclusive distributors or wholesalers including wholesale paper merchants and janitorial supply houses for resale to commercial, industrial, and institutional users. Under these circumstances and considering that applicant's products, like those of opposer, would be made available to service station operators, the sale of these products under the same or similar marks will cause purchasers to ascribe a common origin thereto.

It is opposer's contention that the marks of the parties and, in particular, "HI-DRI" and "SO-DRI", are confusingly similar when considered in their entireties, "having the same connotation, a similar appearance, and a similar ring when spoken". Applicant argues, however, that each of the marks is highly suggestive of the excellent drying qualities of the towel put out by each manufacturer, and that other than this common theme or suggestion, the marks are sufficiently different to obviate any likelihood of confusion in trade.

Opposer's marks "SO-DRI" and "SHUR-DRI" and applicant's mark "HI-DRI" obviously were adopted to suggest that the paper towels sold thereunder possess superior drying qualities. It likewise appears from the record that it has been a common practice for producers of paper

towels and of such competitive products as cloth towels to adopt as trademarks for their products designations comprising the word "DRY" or "DRI", having a similar suggestive connotation, such as "DRI-N-SHINE", "DRI-KLEEN", "DRY-MOR", "SPARKLE-DRI", "EASI-DRI", DRY-FAST", and "WIPEMDRI". Under such circumstances, the scope of protection afforded opposer's marks must necessarily be narrow and manifestly cannot extend to preclude the registration by others of similar but otherwise distinguishable notations or trademarks for towels. See: Stephen L. Bartlett Company v. Arbuckle Brothers, 52 App. D. C. 267 (1923); Hillyard Chemical Company v. Vestal Laboratories, Inc.; Vestal Laboratories, Inc. v. Hillyard Chemical Company, 99 USPQ 117 (CCPA, 1943); Milwaukee Nut Company v. Brewster Food Service, 125 USPQ 399 (CCPA, 1960); Sure-Fit Products Company 1. Saltzson Drapery Company, 117 USPQ 295 (CCPA, 1958); The Murray Corporation of America v. Red Spot Paint and Varnish Co., Inc., 126 USPQ 390 (CCPA, 1960); E. L. Bruce Company v. American Termicide Company, Inc., 128 USPQ 341 (CCPA, 1960); and Air Products, Inc. v. Marquette Manufacturing Co., Inc., 133 USPQ 192 (CCPA, 1962). The fact, as urged by opposer, that its marks and that of applicant are hyphenated marks and the syllable "DRI" appears therein as a prefix instead of a suffix as in the third-party registrations is of no particular significance as evidenced by the decisions in Sure-Fit Products Company v. Saltzson Drapery Company, *supra* (RITE-FIT and SURE-FIT); Hillyard Chemical Company v. Vestal Laboratories, Inc., *supra* (SHINE-ALL and BRITEN-ALL); and Air Products, Inc. v. Marquette Manufacturing Co., Inc., *supra* (REDI-ARC and REDI-SET). Accordingly, although the designations "SO-DRI", "SHUR-DRI", and "HI-DRI" may have similar meanings, the differences

between them in both sound and appearance are sufficient, in view of the nature of the marks, to preclude a likelihood of confusion or mistake as to the source of the goods sold thereunder.

Opposer, in effect, has taken the position that, apart from the interpartes issues in this proceeding, applicant should be refused registration *ex parte* because the first shipment on which the application is based was merely a token shipment made for the express purpose of registration, and hence does not constitute a bona fide use of the mark in commerce; there were no further shipments by applicant under the mark "HI-DRI" until July 1964; and the subsequent shipments were so small for a company of applicant's size and so sporadic "as to have obviously been made for the purposes of the present opposition rather than as a part of bona fide commercial activity".

While an opposer may not ordinarily be heard on an *ex parte* question, in the interest of removing any cloud that may be placed on applicant's activities in regard to its use of "HI-DRI" in the United States, opposer's allegations require that they be considered herein.

There is no question on the record presented but that the first shipment of "HI-DRI" was made by applicant at the request of its legal department to establish a basis for the registration which it now seeks, and that the shipment involved only a dollar and ninety-one cents worth of paper products. The recipient of the shipment, however, was a drug chain which apparently had no connection with applicant; the goods were shipped under a commercial type label, invoiced, and paid for in the usual manner for small shipments; and there is nothing to suggest that these goods were not offered for resale or that the shipment was anything other than a bona fide sale. The fact

that a sale in commerce was made expressly for registration purposes is not damming, *per se*, where circumstances indicate an intent to continue such use. See: Maternally Yours, Inc. v. Your Maternity Shop, Inc., 110 USPQ 462 (CA 2, 1956); Western Stove Company, Inc. v. Geo. D. Roper Corporation *et al.*, 80 USPQ 393 (DC Calif., 1949); Montgomery Ward & Co., Inc. v. Sears, Roebuck & Co., 9 USPQ 524 (CCPA, 1931); and California Spray-Chemical Corporation v. Ansbacher Siegle Corporation, 55 USPQ 298 (Comr., 1942). Admittedly, there were no further shipments in the United States until July 1964; but there is uncontradicted testimony by applicant's witness that, during this interval, applicant was conducting marketing tests and analyses which it deemed necessary prior to merchandising "HI-DRI" products on a national scale. Certainly, the record does not support an intent to abandon the mark during this period nor does the eighteen month interim of sales inactivity establish a *prima facie* case of abandonment as defined in Section 45 of the Statute; and while the sales of "HI-DRI" paper products after July 1964 may not have been of the magnitude normally associated with a manufacturer of applicant's size, they nevertheless were shipments under the mark in question and serve to establish applicant's intent to continue to use and maintain whatever rights it may have acquired in the mark "HI-DRI".

Decision:

The opposition is dismissed.

H. WALDSTREICHER,
S. LEFKOWITZ,
R. F. SHRYOCK,
Members, Trademark Trial and
Appeal Board.

JAN 3 1966

APPENDIX "D"

Excerpts from Trademark Act of 1946, as Amended

Intent of Act. The intent of this Act is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks *used in such commerce* from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, *or colorable imitations of registered marks;* and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations (Amended Oct. 9, 1962, 76 Stat. 769). Sec. 45 (15 U. S. C. 1127.) (Emphasis ours.)

The owner of a trademark used in commerce may register his trademark under this Act on the principal register hereby established:

(a) By filing in the Patent Office—

(1) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes

himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, *that the mark is in use in commerce,* and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive . . . Sec. 1 (15 U. S. C. 1051). (Emphasis ours.)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) ...

(b) ...

(c) ...

(d) consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as *to be likely, when applied to the goods of the applicant, to cause confusion or to cause mistake, or to deceive* . . . Sec. 2 (15 U. S. C. 1052). (Emphasis ours.)